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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,601	03/15/2004	Bert D. Cook JR.	1009-1-3	1816

7590 10/02/2006

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EXAMINER

HESS, DANIEL A

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/800,601		COOK ET AL.	
	Examiner		Art Unit	
	Daniel A. Hess		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 13-37 and 43-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10 and 38-42 is/are rejected.
- 7) ☒ Claim(s) 8, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/15/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to Applicant's initial filing of 3/14/04, which has been placed in the electronic file of record.

Election/Restrictions

This application contains claims directed to the following patentably distinct species:
Group I, figures 1-3 are drawn to a credit card media including an enclosure method of manufacturing. Group II, figures 5, 6, 7A-7C and 7H are drawn to a reader system for the credit card media with enclosure. Group III, figures 4, 7D, 7E-7G and 8 are drawn to a method of reading that media. The species are independent or distinct because the media in the first group could for example, be operated by hand, with a user opening the card by hand, extracting the magnetic disc, and then inserting it by hand into a drive. The reader and method of reading are not required.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

During a telephone conversation with Applicant's representative Mr. Kevin Jablonski on 9/21/06 a provisional election was made without traverse to prosecute the invention of group I, claims 1-12 and 38-42. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-37 and 43-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2876

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7, 9, 10 and 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (Reissue 38,290), of record in the Applicant's information disclosure in view of Conner et al. (2003/0024995) of record in the Applicant's information disclosure.

Re claim 1-4, 9, 10 and 38-41: Rose teaches (see notably figures 1 and 4) a housing consisting of upper and lower portions that are attached to one another enclosing a removable media inside. The inner media is shown in figure 1. The media can clearly be accessed by opening the enclosure (i.e. manipulating one of the upper and lower portions). The media is a disk and can clearly store digital data thereon.

Lacking in Rose is a teaching that the form factor is credit card shaped.

In Conner et al., it is clearly shown that media with a credit card-type form factor can be placed in a disc drive: a card with such media is shown.

In view of Conner et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to give the casing of Rose a credit card form factor so that it can double as a credit card, increasing convenience for the customer, and so that can fit in a wallet or billfold.

Re claims 5 and 42: See figure 4, ref. 28 of Rose et al. There is a groove in both the upper and lower portions. It appears that this groove is wide enough for the two portions to be separated with a fingernail, but a pin would work as well. As for the word 'hole' in the claim, there is no language which requires that the hole be round.

Re claim 6: This Examiner has disassembled floppy discs many years ago and can attest that these normally have had protective pads inside the enclosure on either side of the magnetic data-bearing material. The Examiner further has in his possession examples of such discs which are about 10 years old.

In view of the standard structure of many floppy discs, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known protective pads inside the enclosure to protect data bearing surfaces from scratches which could lead to a loss of data.

Re claim 7: Note the clasp of Rose. It would naturally be flexible, and biases the case to a closed position.

Allowable Subject Matter

Claims 8, 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Re claim 8, the biasing spring that is claimed has no equivalent in the prior art, in the context of the claimed invention.

Re claim 11, the prior art fails to teach, in the context of the claimed invention, a water-tight surface. In fact, the nearest prior art of record, namely Rose and Conner et al. are distinctly not watertight, because it is intentionally made with holes that are used to access and read the data-bearing media inside.

Re claim 12, in the context of all of the limitations upon which the claim depends, the prior art fails to teach or suggest a magnetic ring operable to align the removable media inside the enclosure.

Remarks

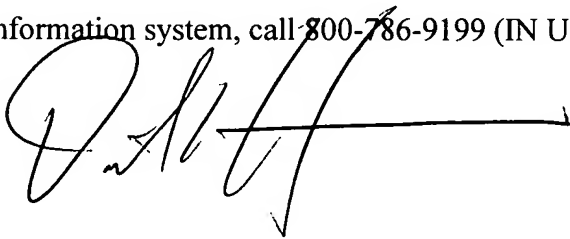
The Examiner notes that in art that he has seen so far, he has not found a reader that takes a card media of the type claimed and opens it up to extract a disc and then process this disc. This would correspond for example to non-elected group II. In Rose for example, the media is manually placed in the adapter by a user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'D. A. Hess', with a long horizontal line extending to the right.

Daniel A Hess
Examiner
Art Unit 2876

9/22/06